

## REMARKS

### 1. Status of the Claims

Currently, Claims 1-6, 9-15, 18, 20-26 and 29 are pending in the present application. Applicant has deleted Claims 1-6, 9-15, 18, and 20, amended Claims 21, 23-26 and 29, and added new Claim 30.

### 2. Claim Rejections Under 35 U.S.C. §112

Initially, the Examiner has rejected Claims 6 and 15 of the present invention under 35 U.S.C. §112, based on the contention that are indefinite. Applicant has deleted the claims, however, and as such submits that the Examiner's rejection is now moot.

### 3. Claim Rejections Under 35 U.S.C. §102

Substantively, the Examiner has rejected now-pending claims 21-26 and 29 under 35 U.S.C. §102(b), based on the contention that they are anticipated by U.S. Patent No.5,169,384, issued to Bosniak et al (Bosniak '384). Applicant respectfully traverses the Examiner's rejection.

Notwithstanding the above traversal, Applicant has amended Claim 21 so as to better define the invention. Claims 22-26 and 29 were amended to conform to the language of Claim 21, and to eliminate any potential formal issues. As amended, Claim 21 is not taught, disclosed or claimed by any prior art reference, including Bosniak '384.

Specifically, the present invention has been amended to claim an ocular apparatus having a housing member configured to be at least partially placed beneath one of the upper and lower

eyelids and directly adjacent an eye of a patient. Furthermore, the present invention additionally includes, *inter alia*, at least one of a lateral straddling member and a medial straddling members, which straddling members are configured to be directly inserted into and cooperation with one of the corners of an eye of a patient. By inserting the housing beneath the eyelid of a patient, and by placing the straddling members within the corners of the eye of the patient, the position of the housing can be registered properly, and maintained throughout ocular treatments using the device.

Bosniak'384 fails wholly to show such a structure at all. Bosniak '384 specifically teaches a device that is intended to overlay the eyes of a patient, (Bosniak '384, col. 4, lines 52-57), to facilitate the application of iontophoresis or TENS to the eyelid. Bosniak '384 is in the form of a mask, with handles (32A and 32B) wrapping around the head of the patient, and securing the mask over the eyelids.

The Examiner has attempted to draw a parallel between the handles (32A and 32B) of Bosniak '384, and the straddling members of the present invention. As can be seen, however, the two structures are not analogous at all. The handles in Bosniak '384 wrap around the head of the patient, and never come near the eye of the patient. Instead, they secure the mask 22 over the eyes of the patient.

The presently claimed invention, on the other hand, claims one or more of a medial and lateral straddling members that are configured for direct insertion into and cooperation with the corners of the eye of a patient. Such a structure can clearly be seen in, for example, Figs. 5 and 6 of the present invention, and as such the present amendments introduce no new matter to the application. The lateral and medial straddling members enable the secure registration of the housing member directly adjacent the eye surface. Thus, the lateral and medial straddling

members have both a different structure and a different function than the straps in Bosniak '384.

4. Conclusion


Based on the above, Applicant submits that Claim 21, as amended, is not taught, disclosed or suggested by Bosniak '384. Furthermore, Applicant notes that the remaining claims, namely Claims 22-26, and 29-30, all depend from Claim 21, and should also now be in condition for allowance. Therefore, reconsideration and passage to allowance of Claims 21-26, and 29-30 is respectfully requested.

Should anything further be required, a telephone call to the undersigned, at (312) 226-1818, is respectfully invited.

Respectfully submitted,

FACTOR & LAKE, LTD.

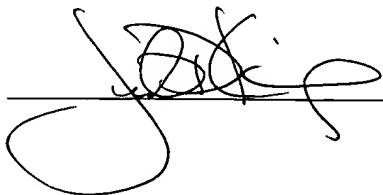
Dated: January 26, 2004

  
\_\_\_\_\_  
Jacob D. Koering  
One of Attorneys for Applicant

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on January 26, 2004.

Jacob D. Koering

  
\_\_\_\_\_